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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,073	06/30/2000	CONNIE T MARSHALL	ODS-9	2964

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EXAMINER

ASHBURN, STEVEN L

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 03/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/609,073

Applicant(s)

MARSHALL ET AL.

Examiner

Steven Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.


MARK SAGER
PRIMARY EXAMINER

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DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over either claims 1-59 of Brenner, U.S. 6,004,211 (Dec. 21, 1999) or claims 1-132 of Brenner, U.S. 5,830,068 (Nov. 3, 1998) ^{each} in view of Lawler, U.S. 5,805,763 (Sep. 8, 1998) ^{mbd}

Brenner discloses an interactive wagering system for "off-track" betting. It claims the following features of relevant to the invention:

- a. Allowing a user to create and place a wager for a given race by interacting with a plurality of wager creation options. See '068, 1, 2, 33, 35, 48-57, See '211, claims 1, 19, 37, 58 and 59. (Claims 1, 19, 37, 48)

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- b. Providing the user with an option to record the given race while the user is interacting with a plurality of wager creation options. See '068, 69, 89, 92, 93, 96, 100, 125. See '211, claims 1, 19, 37, 58 and 59. (Claims 1, 19, 37, 48)
- c. Recording the given race on a video recording device. See '068, 94, 125. See '211, claims 2, 5, 36, 37 and 53. (Claims 1, 12, 13, 37, 41)
- d. Storing race video at a remote location. See '068, 6, 32, 42. See '211, claim 2, 7 (Claim 6)
- e. Allowing users to access and view stored race recordings on a display device. See '068, 24-29. See '211, claims 4, 24. (Claims 7, 37, 47)
- f. Using television equipment as user equipment. See '068, 16, 35, 45, 78. See '211, claim 14, 29, 46, 49 (Claims 11, 38, 40, 50, 52)
- g. Employing a computer as user equipment. See '068, 1, 2, 36. See '211, claim 14, 37, 58, 59 (Claims 14, 43, 53). The examiner interprets to claims use of "terminal" to include computers.
- h. Employing telephone equipment as user equipment. See '068, 31, 66. See '211, claims 11, 18, 29, 47, 54. (Claim 15, 44)
- i. Recording the race in real-time. See '068, 96, 125. See '211, claims 1, 4. (Claim 16)
- j. Recording the race after it has taken place. See '211, claims 1, 4. (Claim 17)
- k. Charging a fee for viewing a video. See '068, 75, 102. See '211, claims 12, 37, 46 (Claims 18, 36).

However, the invention claims the following features not claimed by Brenner:

- a. Allowing the user to selecting "yes" or "no" in response to the option to record the given race. (Claim 2)

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- b. Recording the race in response to the user selecting "yes". (Claim 3)
- c. Storing the race in a personal archive. (Claims 4, 46, 56)
- d. Locating the personal race archive on the user's equipment. (Claims 5, 31)
- e. Locating the personal archive remotely from the user's equipment. (Claims 6, 32, 45)
- f. Allowing users to access the personal archive and view previously recorded races. (Claims 7, 47)
- g. Recording the race with a digital video recorder. (Claims 13, 42)
- h. Locating control circuitry in a set-top box. (Claims 39, 51)

Regardless of Brenner's deficiencies, the above features are known and would be obvious to one with ordinary skill in the art in view of prior references.

Lawler discloses an analogous interactive video system allowing users to search and automatically record broadcast events. The system provides on-demand delivery of event videos ranging from brief clips to full length motion pictures. See col. 4:23-26. Through the interface, users may order videos of past, present or future events. See fig. 7. Similar to Brenner, wherein users may collect race program information and place orders for broadcast racing videos, Lawler allows users to collect entertainment program information and place orders for broadcast event videos. See col. 1:45-2:40. Additionally, Lawler automatically provides the option to record events while he is interacting with the program selection menu. See figs. 6-10. Thus it provides an improved means for ordering broadcast events from an interactive menu because users do not have to enter different menus of steps to place an order. In specific regards to the claims, Lawler discloses the following features:

- a. Allowing a user to create and place an order for an event by interacting with a plurality of wager creation options. See fig. 1-10. (Claims 1, 37)

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- b. Providing the user with an option to record the given race while the user in interacting with a plurality of wager creation options. See fig. 1-9. (Claims 1, 37)
- c. Recording the given race on a videocassette recorder or, alternatively, other digital recording device. See 3:28-67. (Claims 1, 12, 13, 37, 41, 42)
- d. Using television equipment as user equipment. See id. (Claim 11, 38, 40, 50, 52)
- e. Employing a computer as user equipment. See id. (Claims 14, 43, 53)
- f. Employing telephone equipment as user equipment. See 5:29-36. (Claim 15, 44)
- g. Recording the events in real-time. See fig. 7. (Claim 16)
- h. Recording the race after it has taken place. See fig. 7. (Claim 17)
- i. Allowing the user to selecting "order" or "cancel" in response to the option to select the given race. See fig. 10; col. 10:60-64. (Claim 2)
- j. Recording the race in response to the user selecting "order". (Claim 3)
- k. Storing the event in a personal archive. See col. 13:26-37. (Claim 4, 30, 46, 56)
- l. Locating the personal event archive on the user's equipment. See col. 2:14-23. (Claims 5, 31)
- m. Locating the personal archive remotely from the user's equipment. See col. 2:24-35, 13:26-37. (Claims 6, 32, 45)
- n. Allowing users to access and view stored race recordings on a display device. (Claims 7, 37)
- o. Allowing users to access the personal archive and view previously recorded videos. (Claims 7, 47)

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- p. Searching for racing videos located in an archive remotely located from user equipment; displaying the result of the search to the user; and allowing the user to view a n event by selecting a video for the given event from the search on a display device. See figs. 1-10; (Claims 20, 49)
- q. Allowing the user to search for race videos based on search criteria including time, date, length, subject. See 7:10-18. (Claims 21-29, 55)
- r. Locating control circuitry in a "set-top box". See fig. 1. (Claims 39, 51).

As listed above, Lawler describes the remaining features of the claims. However, there remain several aspects of the invention not specifically expressly described by the prior art.

First, Lawler does not specifically allow the to selecting "yes" or "no" in response to the option to record the given race and record the race in response to the user selecting "yes". (Claim 2 and 3) Instead, Lawler allows the user to select "order" or "cancel" and subsequently records the event in response to the user selecting "order". See figs. 5, 8, 9, 10; col. 11:35-43. Although the terminology is different, the method is effectively the same. Thus, in view of Lawler, it would be obvious to require a user to confirm his purchase by inputting "yes" or "no" before incurring a charge by ordering a video.

Second, neither Brenner nor Lawler specifically provide for searching the database based on race-specific criteria including track conditions, jockey name, horse name, trainer name, weather conditions date, or race distance. (Claims 8-10, 33-35 , 21-29, 55) However, Lawler allows users to search a database of event video based on categorical information including name, time, date, genre and event length. See fig. 3; col. 7:10-18. Furthermore, Lawler suggests that the alternate embodiments could employ different categoru-based user guides based on the user's needs. See col. 7:10-18. Thus, in combination with the off-track wagering system taught by Brenner, it would have been obvious to employ different categories relevant to off-track wagering including track conditions, jockey name, horse name, trainer name, weather conditions date, or race distance.

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The suggestion to combine Brenner and Lawler was within the ordinary knowledge of one skilled in the art of gaming at the time of the invention. In general, both Brenner and Lawler describe analogous interactive user interfaces. Even though Lawler is not directed towards wagering, interactive user interfaces are employed both in and out of gaming applications, including home cable-television services. Thus, these interactive user interfaces would have been within the ordinary knowledge in the art of interactive gaming interfaces. In view of Lawler, it would have been obvious to one skilled in the art at the time of the invention to add the to improve Brenner by adding a user interface that automatically provides users the opportunity to record race events while interacting with a wager selection menu in order to provide a quick and easy means of storing broadcast races in a personal archive. See col. 13:38-47.

Response to Arguments

Applicant's arguments filed Jan.28, 2002 have been fully considered but they are not persuasive. Brenner '068 includes automatic recording. See claims 69, 89.

Applicant's arguments with respect to claims 1-56 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703 308 4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305 3590 for regular communications and 703 308 3579 for After Final communications. Any inquiry of a general

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nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1078.



Steven Ashburn
March 20, 2002



MARK SAGER
PRIMARY EXAMINER